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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,051	11/26/2003	Lester F. Ludwig	A8681	8319
23373	7590	03/25/2008	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			STRANGE, AARON N	
ART UNIT	PAPER NUMBER			
		2153		
MAIL DATE	DELIVERY MODE			
03/25/2008	PAPER			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/722,051	<b>Applicant(s)</b> LUDWIG ET AL.
	<b>Examiner</b> AARON STRANGE	<b>Art Unit</b> 2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 14 December 2007.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 37-70 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 37-70 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 20080110/2

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. The Examiner would like to note that the present application has been reassigned to a new Examiner.

***Response to Arguments***

2. Applicant's arguments, see pp. 11-13, filed 12/14/07, with respect to the rejection of claims 37-70 under 35 U.S.C. § 103(a), have been fully considered and are persuasive. That rejection has been withdrawn. However, in view of Applicant's amendments, a double patenting rejection has been set forth below.

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 37-48 and 61-70 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 33 of U.S. Patent No. 6,237,025 in view of:

Swinehart ("Telephone Management in the Etherphone System"), Vin et al. ("Multimedia Conferencing in the Etherphone Environment"), Ahuja et al. (US 5,689,553), Harrison et al. (US 5,796,727), Banks ("America Online: A Graphics Based Success Evaluation") and Baumgartner et al. (US 5,195,086).

As noted by Applicant, each of independent claims 37 and 61 have been amended to incorporate the entire body of issued independent claim 33 of U.S. Patent No. 6,237,025 (Remarks, 11). The remaining limitations of independent claims 37 and

61, and their respective dependents are taught by the combination of Swinehart, Vin, Ahuja, Harrison, Banks and Baumgartner (See Office Action of 6/14/2007, pp. 8-15).

Use of the method for establishing communication with teleconference participants using a directory, claimed in claim 33 of U.S. Patent No. 6,237,025 in a conferencing system such as the one taught by Swinehart, Vin, Ahuja, Harrison, Banks and Baumgartner would have been advantageous, since it would have allowed potential conferees to be located and contacted by prospective conferees.

Therefore, it would have been obvious to one of ordinary skill in the art to use the directory claimed in claim 33 of U.S. Patent No. 6,237,025, in the specific conferencing system taught by Swinehart, Vin, Ahuja, Harrison, Banks and Baumgartner.

5. Claims 49-60 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 22 of U.S. Patent No. 5,758,079 in view of:

Swinehart ("Telephone Management in the Etherphone System"), Vin et al. ("Multimedia Conferencing in the Etherphone Environment"), Ahuja et al. (US 5,689,553), Harrison et al. (US 5,796,727), Banks ("America Online: A Graphics Based Success Evaluation") and Baumgartner et al. (US 5,195,086).

As noted by Applicant, independent claim 49 has been amended to incorporate the entire body of issued independent claim 22 of U.S. Patent No. 5,758,079 (Remarks, 11). The remaining limitations of independent claim 49 and its respective dependents

are taught by the combination of Swinehart, Vin, Ahuja, Harrison, Banks and Baumgartner (See Office Action of 6/18/2007, pp. 8-15).

Use of the method for detection and notification of incoming callers, claimed in claim 22 of U.S. Patent No. 5,758,079, in a conferencing system such as the one taught by Swinehart, Vin, Ahuja, Harrison, Banks and Baumgartner would have been advantageous, since it would have allowed potential conferees to be notified when they were invited to a conference and be notified of the identity of the inviter, so the invitee could be sure they wanted to join the conference.

Therefore, it would have been obvious to one of ordinary skill in the art to use the detection and notification claimed in claim 22 of U.S. Patent No. 5,758,079, in the specific conferencing system taught by Swinehart, Vin, Ahuja, Harrison, Banks and Baumgartner.

#### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. S./  
Examiner, Art Unit 2153  
/Glenton Burgess/

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